UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/668,125	09/21/2000	Rob Tribble	NETS0044	1382

22862 7590 01/30/2007 GLENN PATENT GROUP 3475 EDISON WAY, SUITE L MENLO PARK, CA 94025	EXAMINER
	FRENEL, VANEL

ART UNIT	PAPER NUMBER
3627	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
2 MONTHS	01/30/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

MAILED

JAN 3 0 2007

GROUP 3600

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/668,125
Filing Date: September 21, 2000
Appellant(s): TRIBBLE, ROB

Julia A. Thomas
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/13/06 appealing from the Office action

mailed 08/20/04.

(1)   Real Party in interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial

proceedings which will directly affect or be directly affected by or have a bearing on the

Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection

contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is

correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,400,248   **CHISHOLM**   03-1995

4,210962   **Marsh et al**   01-1980

(9)   Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-4,6-11, 13-18, 20, and 21 are rejected under U.S.C. 103. This rejection

is set forth in the prior Office Action mailed on 08/20/04. The rejection is set forth below

as it appears in the previous Office Action mailed on 08/20/04.

Claims 1-4, 6-11, 13-18 and 20-21 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Chisholm (5,400,248) in view of Marsh et al (4,210,962).

(A)   As per claim 1, Chisholm discloses the steps of:

providing a rule engine (See Chisholm, Col.5, lines 17-34 The Examiner

interprets Chisholm's voter administrator program to be a form of "rules engine");

wherein said rule engine evaluates said business objects (Col.5, lines 23-34 The

Examiner interprets "votes" as "business objects");

providing administration means for allowing a user to maintain preferences for a

specific instance of a business objective (Col.5, lines 12-34);

wherein said rule engine uses business rules to evaluate a relationship between

said business objects (Col.5, lines 55-68 The Examiner understands conditional

votes are votes having a relationship to other votes); and

wherein each business object is a voter that provides votes that are evaluated by

said business rules (Col.5, lines 12-34);

providing rule resolution strategy means for resolving conflicts between specific

preferences of voters and determining a correct solution set (Col.5, lines 55-65; Col.8,

lines 10-44);

wherein a sequence of voters and an order of the votes included for each voter

determines values in said solution set (Col.9, lines 35-50; Col.10, lines 55-68 to Col.11,

line 3) .

Chisholm does not explicitly disclose a process for evaluating business objects

with no prior association and creating dynamic solution sets based on said evaluation in

a computer environment, as recited in the preamble of claim 1.

However, this feature is known in the art, as evidenced by Marsh. In particular,

Marsh suggests a process for evaluating business objects with no prior association and

creating dynamic solution sets based on said evaluation in a computer environment

(See Marsh, Col.3, lines 8-11; Col.4, lines 22-28).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to have included the feature of Marsh within the system of Chisholm with the

motivation of solving dynamic programs in a minimum of time and without the necessity

of complex interprocessor communication (See Marsh Col.2, lines 21-25).

(B)   As per claim 2, Marsh discloses the process further comprising the steps of:

providing domain tables (Col.4, lines 28-55); wherein said tables are used to

define the overall set of possible values for a given attribute of a business object (Col.5,

lines 66 to Col.6, line 31 and Figs 1a-1c); and wherein said tables are static, configured, or dynamic in nature (Col.4, lines 22-28; Col.5, lines 66 to Col.6, line 31 and Figs 1a-1c).

(C)   As per claim 3, Chisholm discloses the process wherein said business rules are configurable, generalized statements of how common processing methods are applied to a specific intersection of data (Col.10, lines 4-30); and wherein said business rules determine privileges, application of business processes, business relationships, choices, and default values (Col.12, lines 1-45).

(D)   As per claim 4, Chisholm discloses the process further comprising the step of: providing rule administration means for allowing a user to define business rule attributes (Col.16, lines 61-68 to Col.17, line 7).

(E)   As per claim 6, Chisholm discloses the process wherein said rule engine returns one solution set for the set of business objects (voters) being referenced (Col.8, lines 30-68).

(F)   As per claim 7, Chisholm discloses the process wherein said business rules are cached (Col.5, lines 10-47).

(G)   Apparatus Claims 8-14 differ from method claims 1-7 by reciting an apparatus

for performing the underlying process steps of method claims 1-7. Since Chisholm

clearly discloses the underlying process steps recited in claims 1-7, it is readily apparent

that Chisholm discloses the necessary apparatus for performing those steps. Note, for

example, the recitation in Chisholm with regard to a programming interface and a

network (Chisholm, Col.4, line 65 to Col.5, line 10).

The remainder of claims 8-14 repeat the same limitations addressed above in the

rejections of claims 1-7, and are therefore rejected for the same reasons given for

claims 1-7.

(H)   Claims 15-21 differ from claims 1-7 by reciting a "program storage medium

readable, tangibly embodying a program of instructions". As per this limitation, Note, for

example, the recitation in Chisholm with regard to a programming interface and a

network (Chisholm, Col.4, line 65 to Col.5, line 10).

The remainder of claims 15-21 repeat the same limitations addressed above in

the rejections of claims 1-7, and are therefore rejected for the same reasons given for

claims 1-7.

(10)   Response to Argument

In the Appeal Brief filed on 01/13/06, Appellant makes the following arguments:

(i) Examiner has failed to satisfy the requirements to establish a prima facie case

of obviousness.

(ii) Chisholm does not teach "votes" as to "business objects".

(iii) Chisholm does not disclose "a process for evaluating business objects with no prior association and creating dynamic solution sets based on said evaluation in a computer environment".

(iv) Chisholm and Marsh fail to teach or suggest providing a rule engine, which evaluates business objects with no prior association and uses business rules to evaluate a relationship between the business objects, each business object being a voter that provides votes that are evaluated by the business rules, wherein a sequence of voters and an order of the votes determine values in a solution set, as claimed in independent claim 1.

.   (v) Sufficient or motivation, modification of Chisholm to incorporate features from Marsh is simply a result of hindsight reconstruction. It is improper to attempt to establish obviousness by using the Appellant's specification as a guide to combing different prior art references to achieve the results of the claimed invention.

Examiner will address Appellant first argument and related points in sequence as they appear in the Brief.

(i)   With respect to Appellant first point of argument, Examiner respectfully submitted that obviousness is not determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See In re Oetiker, 977F. 2d 1443, 1445,24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Hedges, 783F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir.1992); In re Piaseckii, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir.1984); In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA

1976). Using this standard, the Examiner respectfully submits that he has at least

satisfied the burden of presenting a prima facie case of obviousness, since he has

presented evidence of corresponding claim elements in the prior art and has expressly

articulated the combinations and the motivations for combinations that fairly suggest

Appellant's claimed invention. Note, for example, in the instant case, the Examiner

respectfully notes that each and every motivation to combine the applied references are

accompanied by select portions of the respective reference(s) which specially support

that particular motivation and /or an explanation based on the logic and scientific

reasoning of one ordinarily skilled in the art at the time of the invention that support a

holding of obviousness. As such, it is not seen that the Examiner's combination of

references is unsupported by the applied prior art of record. Rather, it is respectfully

submitted that explanation based on the logic and scientific reasoning of one of

ordinarily skilled in the art at the time of the invention that support a holding of

obviousness has been adequately provided by the motivations and reasons indicated by

the Examiner, Ex parte Levengood, 28 USPQ2d 1300(Bd. Pat. App.& Inter., 4/22/93).

Therefore, the combination of references is proper and the rejection is maintained.

In addition, the Examiner recognizes that references cannot be arbitrarily altered

or modified and that there must be some reason why one skilled in the art would be

motivated to make the proposed modifications. However, although the Examiner agrees

that the motivation or suggestion to make modifications must be articulated, it is

respectfully contended that there is no requirement that the motivation to make

modifications must be expressly articulated <u>within the references themselves.</u>

References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, In re Bozek, 163 USPQ 545 (CCPA 1969).

The Examiner is concerned that Appellant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in In re DeLisle 406 Fed 1326, 160 USPQ 806; In re Kell, Terry and Davies 208 USPQ 871; and In re Fine, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing In re Lalu, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in In re Lamberti et al, 192 USPQ 278 (CCPA) that:

(i)   obviousness does not require absolute predictability;

(ii)   non-preferred embodiments of prior art must also be considered; and

(iii)   the question is not <u>express</u> teaching of references, but what they would suggest.

According to In re Jacoby, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In In re Bode, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein.

According to Ex parte Berins, 168 USPQ 374 (Bd. Appeals), there is no statutory limitation as to the number of references that may be used to demonstrate obviousness...not what references expressly state but what they would reasonably suggest to one of ordinary skill in the art. In In re Conrad, 169 USPQ 170 (CCPA),

obviousness is not based on <u>express</u> suggestion, but what references taken collectively would suggest.

Nonetheless, it is respectfully submitted that an explanation based on logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner in the previous Office Action, *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

Furthermore, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The skilled artisan would not consider the prior art embodiments in a vacuum, but would have had the motivation to combine the advantageous features of the prior art in the manner purported by the Examiner for the reasons and motivations given in the prior Office Action. Thus, the teachings of Chisholm and Marsh when considered with the knowledge that is generally available to one of ordinary skill in the art make obvious the limitations that Applicant disputes. Therefore, Appellant's argument is not persuasive and the rejection is hereby sustained.

(ii)   With respect to Appellant's second through third point of arguments, Examiner respectfully submitted that He has relied upon Chisholm for the teaching of "a rule engine" which correspond to voter administrator program (See Chisholm, Col.5, lines 17-34). In addition, Examiner respectfully submitted that He has relied upon Chisholm for the teaching of "each business object being a voter (See Chisholm, Col.5, lines 12-

34) that provides votes that are evaluated by the business rules, wherein a sequence of voters and an order of the votes determine values in a solution set (See Chisholm, Col.9, lines 35-50; Col.10, lines 55-68 to Col.11, line 3) which correspond to Appellant claimed feature. Therefore, Appellant argument is not persuasive and the rejection is hereby sustained.

With regard to the teaching of "evaluating a relationship objects with no prior association and uses business rules...". Examiner respectfully submitted that Marsh suggests "dynamic programming is an approach for solving optimization (maximization or minimization) problems, relying on dissecting the main optimization problem into many intermediate optimization problems" since Marsh has been using variables which provide an absolute optimum transition in each state space (See Marsh, Col.3, lines 8-11; Col.4, lines 22-28) which correspond to Appellant's claimed feature. Furthermore, Appellant does not provide anything in the claims or the specification that requires "voter" to be a machine, element, per se. Therefore, Appellant argument is not persuasive and the rejection is hereby sustained.

(iii)   In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Applicant's disclosure, such a

reconstruction is proper. See In re *McLaughlin,* 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

   For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

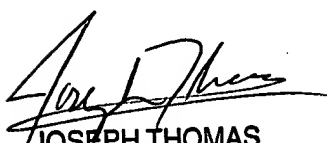Vanel Frenel (V. F)

Patent Examiner

Art Unit 3626

March 30, 2006

CONFEREES:

Joseph Thomas

Supervisory Patent Examiner

Art Unit 3626

Sam Sough

Supervisory Patent Examiner

Art Unit 3628

JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER

Julia A. Thomas

GLENN PATENT GROUP

3475 EDISON WAY, SUITE L

MENLO PARK, CA 94025